



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,194	10/28/2003	Denis Francois Hochstrasser	108140.00030	4418
38485	7590	03/19/2008	EXAMINER	
ARENT FOX LLP			SWARTZ, RODNEY P	
1675 BROADWAY			ART UNIT	
NEW YORK, NY 10019			PAPER NUMBER	
			1645	
			NOTIFICATION DATE	
			DELIVERY MODE	
			03/19/2008	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

NYIPDocket@arentfox.com

Patent_Mail@arentfox.com

Office Action Summary

Application No.

10/695,194

Applicant(s)

HOCHSTRASSER ET AL.

Examiner

Rodney P. Swartz, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-38 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) 20, 23-28 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-19, 21, 22, 29-38 and 40-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-6, 8-38 and 40-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' Response to Office Action, 11 January 2007, is acknowledged. Claims 1, 2, 3, 21, 29, 32, 33, 35, 36, 37, 49, 41, and 43 have been amended.

Claims 1-6, 8-38, and 40-47 are pending. Claims 20, 23-28, and 47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

2. Claims 1-6, 8-19, 21, 22, 29-38, and 40-46 solely drawn to a method and kit for diagnosis of TSE using polypeptide are under consideration.

Rejection Maintained

3. The rejection of claims 29-31 under 35 U.S.C. 112, second paragraph, as being indefinite for identity of "probe", is maintained.

Applicants argue that the amendment of the claims provides more definition to the probe.

The examiner has considered applicants' argument, but does not find it persuasive. As newly amended, claim 29 now recites two components, i.e., "a kit comprising a probe or protein chip array". The description of structural characteristics appears to be only of the protein chip array. Thus, the identity of the probe remains unclear.

4. The rejection of claims 1-6, 8-19, 21, 22, 29-38, and 40-46 under 35 U.S.C. 112, first paragraph, scope of enablement for differentiation of any/all forms of TSE by mere alteration of level of nonspecified proteins, is maintained.

Applicants argue that the amendments of the claims to limit the claims to detection/diagnosis of BSE or CJD obviates the enablement rejection.

The examiner has considered applicants' argument and claim amendments, but does not find it persuasive. While the amendment does restrict the TSE to BSE or CJD, the claims retain

the recitation: "comparing the test amount of the polypeptide in the sample to **a** reference amount of the polypeptide". This requirement is not linked to any specific amount, i.e., normal or abnormal. Thus, the claims remain not enabled due to this aspect of the comparison, i.e., **a** reference amount, versus the amount found in the normal samples.

Conclusion

5. No claims are allowed.
6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Wednesday from 9:00 AM to 7:30 PM EST. Thursday is the examiner's work at home day.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Shannon Foley, can be reached on (571)272-0898.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rodney P. Swartz, Ph.D./

Primary Examiner, Art Unit 1645

March 11, 2008